

## REMARKS

### I. Claim Rejections - 35 USC § 103

#### Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

***Komar in view of Kitsukawa***

The Examiner rejected Claims 1-10 and 12-20 under 35 U.S.C. §103(a) as being unpatentable over Komar et al (US Patent Publication No. 2003/0079224 A1), hereinafter referred to as "Komar", in view of Kitsukawa et al. (U.S. Patent No. 6,282,713 B1), hereinafter referred to as "Kitsukawa".

Regarding claims 1 and 10, the Examiner argued that Komar discloses a method and system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph [0024]) (The Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operation like searching. The Examiner argued therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images.); associating at least one object with a data item of said at least one data item, wherein said at least one object contains information relevant to said data item (citing Komar page 4, paragraph [0031]) (once selected the information about item is available therefore an object associated with the data item) and displaying said data item in allocation of a display screen proximate to said at least one object, and wherein a selection of said at least one object invokes a display of said information relevant to said data item, wherein said data item is displayed simultaneously with said display of said

information relevant to said data item (citing Komar page 2, paragraph [0016] and page 3, paragraph [0025]).

However, the Examiner admitted that Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. However the Examiner argued that Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing Kitsukawa FIG. 5 and col. 8, lines 57-67). Therefore, the Examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view to show detailed images of possible selections.

The Applicant respectfully disagrees with this assessment and notes that claim 1 and 10 have been amended with method claim 1 shown, for example, as follows:

A method, comprising:

maintaining a searchable digital image database wherein said digital image database contains at least one data item comprising a digital image;

associating at least one object with a data item of said at least one data item, wherein said at least one object contains information relevant to said data item and wherein said at least one object comprises an iconette and further wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only; and

displaying a compacted view of said data item in a location of a display screen proximate to said at least one object, wherein said compacted view of said data item is a compacted representation of said data item, and wherein a selection of said at least one object invokes a display of said information relevant to said data item wherein said compacted view of said data item is displayed simultaneously with said display of said information relevant to said data item.

The Applicant has amended claims 1 and 10 to include the additional limitations of: 1) at least one data item comprising a digital image; 2) wherein said at least one object comprises an iconette; and 3) wherein said information relevant

to said at least one data item comprises detailed information about said at least one digital image only.

The Examiner has cited Komar for disclosing displaying relevant information about the data item and has invited the Applicant to clarify the meaning of "information relevant" to said data item. The Applicant has included the additional limitation wherein the information relevant to said at least one data item comprises *detailed* information about said at least one *digital image only*.

Komar discloses a method and system wherein a video stream includes interactive areas wherein information on a *product* displayed can be retrieved. The Applicant claims a data item (a digital image), a compacted view of the data item and information relevant to the *data item* itself, i.e. the digital image. Komar, on the other hand, displays information on the *product* pictured in the video stream. Information relevant to the *digital image only* is not the same as information about the *subject* of the digital image.

In the "Response to Arguments" section of the current office action the Examiner states:

"Komar discloses as noted by Applicant that a sport drink is selected and information about the sports drink is made available. This is considered relevant information about the image selected."

The Applicant submits that a digital image of an item is not the item itself; otherwise an image of a sports drink would quench a user's thirst. Obviously this does not happen, therefore, the image and the item in the image are separate entities; the digital image being a string of zeros and ones on a computer and the item being what it actually is. Therefore, the Examiner's statement about Komar above is technically incorrect as Komar discloses selecting *an image of a sports drink* and information about the sports drink is made available. The Applicant's invention discloses selecting an *image* and information on the *image* is made available.

As argued before, if selecting the image in Komar made available information about the image, it would be information about the *digital image*, not the product. Information about a digital image would be information about the string of zeros and ones; i.e. copyright, file size, image user permissions, etc. Information about the product is information about a completely different entity from the digital image. For example, selecting information about a sports drink would be information such as ingredients or calories of the drink, locations where purchase of the drink is available, etc. This is not information relevant to the *image* as disclosed and claimed in the Applicant's invention.

Furthermore, there is not an obviousness motivation in Komar to display information about the digital image, as Komar teaches that the motivation for the information pertains to the product. Komar is a product advertising method. Information about the digital image and not about the product displayed in Komar would be useless to a user, as Komar discloses that the method is for a user to retrieve further information on products displayed in a video stream in order to sell the product. If the Examiner asserts that it would be obvious to display information relevant to the *digital image* in Komar, what is the motivation of either an advertiser or a purchaser of a product to have information about the digital image of a product and not information about the product itself? In fact, the Applicant submits that information about the digital image would detract from the advertising message would not be the motivation of an advertiser. Therefore, Komar teaches away from displaying information about the digital image.

Additionally, the Examiner has cited Komar for disclosing that a searchable database is disclosed. However, Komar does not expressly disclose a database in the Examiner's citation, disclosing an external data source. Furthermore, how would this "external data source" of Komar be searchable? In order to be a searchable database of images, a user would have search parameters such as subject, photographer etc. A user in Komar does not *search* a database with any search parameters. For example, a library with books may be a "database" of printed

material however without a method of cataloging by subject, title or author it is not a *searchable* printed database. In the same way, Komar does not disclose a searchable database as a user is unable to search for digital images utilizing any search parameter.

Therefore, Komar fails to disclose 1) displaying relevant information about the data item wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only; or 3) a searchable database.

The Examiner has combined the Komar and Kitsukawa references, arguing that the motivation to combine the references is "to have the compacted view to show detailed images of possible selections". The Applicant respectfully submits that this motivation as cited by the Examiner does not make any logical sense. How would a "compacted view" show *detailed* images of a non-compacted image? In other words, how would a thumbnail view show *greater* detail than the full image (i.e. the detailed image)? The Applicant submits that a compacted view inherently cannot show more detail than a full-sized image. The Applicant reminds the Examiner that the U.S. Supreme Court has ruled that a reason to combine must be made explicit. Additionally, the MPEP states that a reasonable expectation of success of the combination must be shown by the Examiner to make a *prima facie* case of obviousness. As a compacted view of an image cannot show greater detail than a full-sized image, the Applicant submits there would be no motivation by one of ordinary skill in the art to combine the Komar and Kitsukawa references as cited by the Examiner.

The Examiner has cited Kitsukawa only for the disclosure of a compacted view of a digital image and not any of the other limitations cited by the Examiner as disclosed in Komar; therefore, Komar in view of Kitsukawa fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's invention is not disclosed. Additionally, the Applicant submits that there would not be a motivation by one of ordinary skill in the art to combine the Komar

and Kitsukawa references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §1-3(a) rejections of claims 1 and 10 based on the Komar and Kitsukawa references be withdrawn.

Regarding claims 2 and 12, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses automatically invoking display of information relevant to said data item in response to dragging a graphically displayed cursor across said at least one object displayed on said display screen (citing Komar, page 2, paragraph [0021] and page 4, paragraphs [0031] and [0032]).

Regarding claim 3, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claim 1 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]).

Regarding claims 4 and 14, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item (citing Komar, page 3, paragraph [0025] and page 4, paragraphs [0031] and [0032]).

Regarding claims 5 and 15, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item as in claims 4 and 14 above and further discloses that the additional graphical window comprises an interactive region for initiating at least one user transaction thereof (citing Komar, page 2, paragraph [0016]).

Regarding claim 6 and 16, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses at

least one object as a graphical iconette displayable on said display screen (citing Komar, page 2, paragraph [0016]; page 4, paragraph [0004] and page 31).

Regarding claims 7 and 17, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses that the item comprises a graphical image (Komar, page 2, paragraph [0017]; page 3, paragraph [0026]).

Regarding claims 8 and 18, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses displaying a compacted view of a plurality of data items in a display area of a display screen, wherein at least one data item among said plurality of data items is displayed proximate to at least one object containing information relevant to said at least one data item, wherein a selection of said at least one object invokes a display of information relevant to said at least one data item (citing Komar, page 2, paragraph [0016]; page 23, paragraph [0023]; and page 4, paragraph [0031]).

Regarding claim 9, the Examiner argued that Komar and Kitsukawa disclose a method as in claim 1 above and further discloses: a) displaying data associated with said data item as a graphical icon on said display screen (citing Komar, page 2, paragraphs [0016] and [0020]); and b) displaying said at least one object as an a graphical iconette embedded within a graphical frame surrounding said graphical icon, wherein said graphical iconette can be invoked by said user to display information relevant to said graphical icon (citing Komar, page 4, paragraph [0031]).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 applies equally against the rejections of claims 2-9, 12 and 14-18 as these claims are dependent upon either claim 1 or 10. As submitted above, Komar in view of Kitsukawa fails in the aforementioned prima facie obviousness test as each and every limitation of the Applicant's independent claims is not disclosed. Additionally,



as submitted above, there would be not be a motivation to combine the Komar and Kitsukawa references as cited by the Examiner.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 2-9, 12 and 14-18 based on the Komar and Kitsukawa references be withdrawn.

***Komar in view of Kitsukawa and Willner***

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Komar and Kitsukawa as applied in claim 10, and further in view of Willner et al. (U.S. Patent No. 7,149,370), hereinafter referred to as "Willner".

Regarding claim 13, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claim 10 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). The Examiner admitted that the combination does not explicitly disclose wherein said object of information includes at least one of the following; copyrights, tile size, tile format, royalties file permissions and conditions of use.

However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner. The Examiner argued that one would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them of the possible capabilities.

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 over Komar in view of Kitsukawa applies equally against the rejection of claim 13 as this claim is dependent upon claim 10.

Additionally the Applicant submits that there would be no motivation to combine the Komar, Kitsukawa and Willner references as argued by the Examiner. The Examiner stated "One would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them of the possible capabilities". The Examiner has cited the Willner reference for disclosing providing additional information about images, including *file* size. However, the Examiner has not stated why a user of Komar would be motivated to provide additional information about the *file size of the image*.

Komar is an advertising system and method wherein the *product* is the item of interest, not the digital image. Why would anyone be interested in knowing the file size of the digital images as disclosed by Willner in the system of Komar? Knowledge of the file size would provide no incentive to a user to purchase the product advertised in Komar, nor would it provide any information about the product itself; i.e. it would not enhance the user's knowledge and would not provide any useful information about possible capabilities of the *product* advertised in Komar. Relevant information in the Komar system and method is relevant to the product not the digital image. The Examiner has not submitted any explicit reason why a user of Komar would be motivated to provide digital image file size information to prospective customers of the product and therefore has not made a *prima facie* case of obviousness as one of ordinary skill in the art would not be motivated to modify Komar as in the Willner reference.

Therefore the Applicant submits that Komar in view of Kitsukawa and further in view of Willner fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Additionally, the Examiner has not provided an explicit reason why one of ordinary skill in the art would be motivated to combine the references.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 13 based on the Komar, Kitsukawa and Willner references be withdrawn.

***Komar in view of Kitsukawa and Gayraud***

The Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa and Gayraud et al. (U.S. Patent No. 5,436,637), hereinafter referred to as "Gayraud".

Regarding claim 20, the Examiner argued that Komar discloses a system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph [0024]; the Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operation like searching. The Examiner argued that therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images); at least one iconette associated with a data item of said at least one data item wherein said at least one iconette contains information relevant to said to data item (citing Komar page 4, paragraph [0031]; the Examiner argued that once selected, the information about the item is available therefore an icon or iconette is associated with the item and a display module for displaying a compacted view of said data item in a location of a display screen proximate to said at least one iconette), and wherein a selection of said at least one iconette invokes a display of information relevant to said data item and wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing Komar page 3, paragraph [0025]; page 2, paragraph [0016]; page 2, paragraph [0020]; and page 4, paragraph [0031]).

However, the Examiner admitted that Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. However, the Examiner argued that Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing Kitsukawa FIG. 5, col. 8, lines 57-

67). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view to show detailed images of possible selections.

The Examiner further admitted that Komar does not explicitly disclose wherein said display module displays data associated with said data item as a graphical icon on said display screen, however the Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1 and 10 applies equally against the rejection of claim 20. The Applicant further notes that claim 20 has been amended similar to claims 1 and 10. As submitted above, Komar fails to disclose 1) displaying relevant information about the data item wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only; or 3) a searchable database.

Gayraud does not disclose the above limitations. Therefore, Komar in view of Kitsukawa and Gayraud fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Additionally, as submitted above, one of ordinary skill in the art would not be motivated to combine the Komar and Kitsukawa references, as submitted above.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 20 based on the Komar, Kitsukawa and Gayraud references be withdrawn.

***Komar in view of Kitsukawa, Gayraud and Willner***

The Examiner rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, and Gayraud as applied in claim 20 and further in view of Willner.

Regarding claim 21, the Examiner argued that Komar, Kitsukawa and Gayraud disclose a method and system as in claim 20 above and further discloses a selection module for selecting said at least one iconette to invoke said display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). However, the Examiner admitted that Komar, Kitsukawa and Gayraud do not explicitly disclose wherein said object of information includes at least one of the following; copyrights, file size, file format, royalties file permissions and conditions of use. However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col.8, lines 24-31). The Examiner argued that one would have been motivated to provide file information to inform user of specific details which can enhance user's knowledge and inform them of the possible capabilities.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1, 10, 13 and 20 applies equally against the rejection of claim 21. As submitted above, there would be no motivation to combine the Komar, Kitsukawa or Willner references. Additionally, the Komar reference does not disclose all of the limitations of the base claim upon which claim 21 is dependent, as argued above.

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Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103 (a) rejection of claim 21 based on the Komar, Kitsukawa, Gayraud and Willner references be withdrawn.

**II. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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Kermit Lopez  
Attorney for Applicants  
Registration No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484  
505-314-1312